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OFFICE OF PETITIONS

In re Patent No. 7,558,433 :
Todor Georgiev :
Issue Date: July 7, 2009 :
Application No. 10/748,013 : DECISION ON REQUEST FOR
Filed: December 30 2003 : RECONSIDERATION OF
Attorney Dkt. No. 07844- : PATENT TERM ADJUSTMENT
624001/P577 :
Title: Healing By Texture :
Synthesis In Differential Space :
: :

This is in response to the " Application For Patent Term Adjustment Under 37 CFR §1.705(d)" filed September 3, 2009. Patentees request that the patent term be adjusted from 942 days to 980 days.

The request for reconsideration of patent term adjustment is **DISMISSED**.

On July 7, 2009, the above-identified application matured into US Patent No. 7,558,433 with a patent term adjustment of 942 days. This request for reconsideration of patent term adjustment (including the required fee) was timely filed within two months of the issue date of the patent. See 37 CFR 1.705(d).

Patentee requests recalculation of the patent term adjustment based on the decision in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentees assert that pursuant to Wyeth, a PTO delay under 35 U.S.C. §154(b)(1)(A) overlaps with a delay under 35 U.S.C. §154(b)(1)(B) only if the delays "occur on the same day." Patentee maintains that the period of adjustment due to the Three Year Delay by the Office, pursuant to 37 CFR § 1.703(b), 38 of 310 days, does not overlap with the 942 day period of adjustment due to examination delay, pursuant to 37 CFR §1.702(a), as these periods do not occur on the same day.

Patentee submits that the total period of adjustment for Office delay is the sum of the period of three-year delay (310 days) and the period of examination delay (942 days) to the extent these periods do not overlap. As such, patentees assert entitlement to a patent term adjustment of 980 days (942 days plus 310 days less 272 days of overlap).

The Office finds that as of the day before the filing of the request for continued examination (RCE) on November 4, 2007¹, the application was pending three years and 309 days after its filing date. An entry of a period of adjustment of 942 days was entered for Office delay. At issue is whether patentee should accrue an additional 309 days of patent term adjustment for the Office taking in excess of three years to issue the patent as well as 942 days for Office failure to take a certain action within a specified time frame (or examination delay).

Patentee's calculation of the period of overlap is inconsistent with the Office's interpretation of this provision. 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

To the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

Likewise, 37 CFR 1.703(f) provides that:

To the extent that periods of delay attributable to the grounds specified in §1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as

¹ It is noted that Patentee is correct the first request for continued examination (RCE) was filed November 5, 2007, not October 5, 2007.

permitting patent term adjustment under both 35 U.S.C. 154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 56366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004).

As such, the period for over 3 year pendency does not overlap only to the extent that the actual dates in the period beginning three years after the date on which the application was filed overlap with the actual dates in the periods for failure of the Office to take action within specified time frames.

In this instance, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A) is the filing date December 30, 2003 until the day before the filing of the RCE on November 4, 2007. Prior to the issuance of the patent, 942 days of patent term adjustment were accorded for the Office failing to respond within a specified time frame during the pendency of the application.

The Office did not delay 942 days and then delay an additional 309 days. Accordingly, 942 days of patent term adjustment for

Office delay (not 942 days and 309 days) was properly entered because the entire period of delay of 309 days attributable to the delay under 37 CFR 1.702(b) overlaps with the 942 days attributable to grounds specified in § 1.702(a)(1).

Accordingly, at issuance, the Office properly entered no additional days of patent term adjustment.

In view thereof, the Office affirms that the revised determination of patent term adjustment at the time of the issuance of the patent was 942 days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Telephone inquiries specific to this matter should be directed to Charlema Grant, Petitions Attorney, at (571) 272-3215.

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